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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/697,434      | 10/31/2003  | Thomas Arend         | 08516.0007          | 7744             |

22852 7590 05/30/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

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| EXAMINER |
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CONTINO, PAUL F

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2114

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/697,434

Applicant(s)

AREND, THOMAS

Examiner

Paul Contino

Art Unit

2114

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim [1] is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims [1, 4, and 7] of copending Application No. 10/697,433. Although the conflicting claims are not identical, they are not patentably distinct from each other as follows:

Claims 1, 4, and 7 of application ‘433 contain every element of claim 1 of the instant application and as such anticipate claim 1 of the instant application, with the exception of a second main system. Though claims 1, 4, and 7 of application ‘433 teach only of a single main

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system, while claim 1 of the instant application teaches of a first and second system, there is no extra processing occurring on or between the second system and the service system. The Examiner takes Official Notice that it is well-known in the art for more than one computer to be connected in a network environment and to have a single system service multiple computers in a network in order to reduce the resources necessary for a fault tolerant environment. It is also well-known in the art for a system to comprise a database, an application, and a front-end server in a fault-tolerant environment.

“A later patent claim is not patentably distinct from an earlier patent/application claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims [1], [6], and [8] are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims [1, 2, 5, 21, and 22], [11], and [9], respectively, of copending Application No. 10/697,431.

Claims 1, 21, and 22 of application '431 contains every element of claim 1 of the instant application and as such anticipate claim 1 of the instant application, with the exception of a second main system. Though claims 1, 21, and 22 of application '431 teach only of a single

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main system, while claim 1 of the instant application teaches of a first and second system, there is no extra processing occurring on or between the second system and the service system. The Examiner takes Official Notice that it is well-known in the art for more than one computer to be connected in a network environment and to have a single [auxiliary] system service multiple computers in a network in order to reduce the resources necessary for a fault tolerant environment.

“A later patent claim is not patentably distinct from an earlier patent/application claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim 2 of application '431 differs from claim 1 of the instant application in that claim 2 teaches of a client/server configuration. The Examiner takes Official Notice that it is well-known in the art to arrange a computer system in a client/server configuration with a database in a fault tolerant system.

Claim 5 of application '431 differs from claim 1 of the instant application in that claim 5 teaches of “cooperation” between the main and auxiliary/service systems. The Examiner interprets a cooperation between the main and auxiliary system to be inherent in order to collect the problem related data as claimed in claim 1.

Claim 9 of application '431 differs from claim 8 of the instant application in that claim 9 teaches of lexicon to determine the version of a system. The Examiner interprets a "check lexicon" and a "lexicon" as claimed to be equivalent in function.

Claim 11 of application '431 differs from claim 6 of the instant application in that claim 11 teaches of "regular" updates of a knowledge representation. The Examiner does not give weight to the term "regular" as claimed in order to prevent claim 11 of application '431 from conflicting with claim 6 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim [1] is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim [1] of copending application No. 10/522,526. Although the conflicting claims are not identical, they are not patentably distinct from each other as follows:

Claim 1 of application '526 contain every element of claim 1 of the instant application and as such anticipate claim 1 of the instant application, with the exception of a second main system. Though claim 1 of application '526 teaches only of a single main system, while claim 1 of the instant application teaches of a first and second system, there is no extra processing occurring on or between the second system and the service [auxiliary] system. The Examiner takes Official Notice that it is well-known in the art for more than one computer to be connected

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in a network environment and to have a single [auxiliary] system service other computers in a network.

“A later patent claim is not patentably distinct from an earlier patent/application claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Objections*

5. Claim 2 is objected to because of the following informalities: in line 2, in order to apply prior art, it is interpreted that the first and second main system each contain a respective single auxiliary system. The Examiner recommends the Applicant include the language “respectively” after “first and second auxiliary systems”. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the first and second service systems" in line 1, where there is only a single service system disclosed. There is insufficient antecedent basis for this limitation in the claim. In order to apply prior art, the Examiner interprets "first and second service systems" and the first and second "main systems".

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer program product in itself may not be patented. The Examiner recommends the Applicant include "a computer program product *stored in a computer-readable medium*" or similar language in order to overcome the 35 USC 101 rejection.



***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bajpai (WO 97/15009).

As in claim 1, Bajpai discloses a distributed computer system comprising:

a first main system and a second main system, both to execute applications in cooperation with a human user (*Figs. 1 and 2; page 10 lines 29-30, where multiple diagnostic elements 28 are interpreted as comprising a first and second main system*); and

a service system to evaluate problems in the first and second main systems (*Figs. 1 and 5; page 9 line 22 and page 10 lines 17-21, remote processor 12*), the service system comprising a service module to collect problem related data from the main systems (*page 9 lines 28-29*), an acquisition module to acquire knowledge representations (*Fig. 5 #56; page 5 lines 18-20 and page 10 lines 24-25, where expert system 56 is interpreted as acquire knowledge representations from problem-solution database 60*), a knowledge module to store the knowledge representations (*Fig. 5 #60; page 10 lines 1-2 and 24-27*), and an inference module for processing problem related data with knowledge representations to identify solutions (*Fig. 5 # 56; page 10 lines 24-*

27, *expert system 56*), the inference module forwarding the solutions through the service module to the main systems (*page 11 lines 15-16*).

As in claim 2, Bajpai discloses the first and second main systems have first and second auxiliary systems[, respectively,] with auxiliary knowledge representations to evaluate problems in the main systems and to escalate problem evaluation to the service system (*Figs. 1 and 2 #30; page 6 lines 22-24 and page 11 lines 5-6*).

As in claim 3, Bajpai discloses the knowledge representations in the service system are enhanced in comparison to the auxiliary knowledge representations in the first and second auxiliary systems (*page 9 lines 22-23*).

As in claim 4, Bajpai discloses the knowledge representations are enhanced in volume, actuality and complexity (*page 9 lines 22-23*).

As in claim 5, Bajpai discloses the first and second auxiliary systems forward problem data to the service system after preliminary data analysis by processing with the auxiliary knowledge representations (*page 9 lines 19-29*).

As in claim 6, Bajpai discloses the services system updates the auxiliary knowledge representations in first and second auxiliary systems (*page 9 lines 26-27*).

As in claim 7, Bajpai discloses the first and second [main] systems each have a service module to collect problem related data from the main systems (*Fig. 2 #30; page 5 lines 14-15*), an acquisition module to acquire knowledge representations (*Fig. 2 #30; where expert system 30 is interpreted as acquire knowledge representations from expert system databases 34,36,38*), a knowledge module to store the knowledge representations (*Fig. 2 #s 34,36,38; page 5 lines 18-20*), and an inference module for processing problem related data with knowledge representations to identify solutions (*Fig. 2 #30; page 5 lines 18-20*), the inference module for selectively forwarding the solutions through the service module to the main systems and forwarding data to the service system (*page 11 lines 5-6*).

As in claim 9, Bajpai discloses a method for solving a problem in at least one main computer system by expert systems, comprising:

detecting the problem in the main system (*page 5 lines 14-15*);

processing problem related data with a first set of knowledge representations of a first expert system to search for a solution (*page 5 lines 18-20*);

depending on processing results, selectively solving the problem by the first expert system (*page 7 lines 14-16*) or forwarding the problem related data together with search results to a second expert system with a second set of knowledge representations (*page 6 line 11, page 9 lines 19-22 and 28-29, and page 10 lines 3-9, where it is implied the search carried out by a first expert system was insufficient and requires further search by a second expert system*);

processing the problem related data, the search results and the second set of knowledge representations by the second expert system to search for the solution (*page 10 lines 17-21 and page 11 lines 5-24*); and

depending on processing results, selectively solving the problem by the second expert system (*page 11 lines 19-24*) or presenting search results of both searches and problem related data to a human (*page 11 lines 25-29*).

As in claim 10, Bajpai discloses a computer program product comprising program code means for performing the method of claim 9 when the computer program product is run on a computer (*page 5 lines 1-6*).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bajpai in view of Aslanian et al. (U.S. Patent No. 5,111,384).

As in claim 8, Bajpai teaches the inference module applies the knowledge representations for both main systems. However, Bajpai fails to explicitly teach of distinguishing the main system versions. Aslanian et al. teaches of distinguishes version differences of the main systems by looking up in a check lexicon (*page 2 lines 3-43, page 3 lines 38-43, and page 8 lines 23-38*).

It would have been obvious for a person skilled in the art at the time the invention was made to have included the version distinguishing as taught by Aslanian et al. in the invention of Bajpai. This would have been obvious because the invention of Aslanian et al. offers a time and resource efficient means of utilizing an expert system and a knowledge representation base in order to solve a problem (*page 1 lines 66-68*). Further, Aslanian et al. implies distinguishing of main system versions through the examination of various operating system files and the Registry (*page 9 lines 26-27 and page 10 lines 3-9*).

As in claim 11, Bajpai teaches an inference module (*Figs. 1 and 5; page 9 line 22 and page 10 lines 17-21, remote processor 12*) with expertise functionality for evaluating problems in first and second main computer systems that execute an application (*Figs. 1 and 2; page 10 lines 29-30, where multiple diagnostic elements 28 are interpreted as comprising a first and second main system*), wherein the inference module is adapted to process problem related data with knowledge representations to identify solutions (*Fig. 5 # 56; page 10 lines 24-27, expert system 56*), the inference module characterized in that the inference module is part of a service system that receives problem related data from the first and second main systems of different versions over a network (*Fig. 1; page 9 lines 28-29 and page 10 lines 10-15*), wherein the inference module applies the knowledge representations for both main systems (*Fig. 5 #56; page*

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*10 line 24 through page 11 line 24).* However, Bajpai fails to explicitly teach of distinguishing the main system versions. Aslanian et al. teaches of distinguishes version differences of the main systems by looking up in a check lexicon (*page 2 lines 3-43, page 3 lines 38-43, and page 8 lines 23-38*).

It would have been obvious for a person skilled in the art at the time the invention was made to have included the version distinguishing as taught by Aslanian et al. in the invention of Bajpai. This would have been obvious because the invention of Aslanian et al. offers a time and resource efficient means of utilizing an expert system and a knowledge representation base in order to solve a problem (*page 1 lines 66-68*). Further, Aslanian et al. implies distinguishing of main system versions through the examination of various operating system files and the Registry (*page 9 lines 26-27 and page 10 lines 3-9*).

\* \* \*

10. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bajpai in view of Aslanian et al. (U.S. Patent No. 5,111,384), further in view of Cha et al. (WO 01/18652 A1).

As in claim 12, the combined invention of Bajpai and Aslanian et al. teaches the elements of claim 11. However, the combined invention of Bajpai and Aslanian et al. fails to teach of an enterprise resource planning system. Cha et al. teaches of an enterprise resource planning system

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*(Fig. 4; page 4 lines 17-18, page 7 lines 3-10, and page 11 lines 18-24, where the R/3 system is interpreted as an enterprise resource planning system)*

It would have been obvious for a person skilled in the art at the time the invention was made to have included the enterprise resource planning system as taught by Cha et al. in the combined invention of Bajpai and Aslanian et al. This would have been obvious because the invention as taught by Cha et al. offers a time and cost efficient expert system for diagnosing problems *(page 2 lines 5-12)*. Further, it is well-known in the art to implement expert system diagnostics in an enterprise resource planning system [R/3] environment *(Applicant's Specification paragraph [024])*.

As in claim 13, the combined invention of Bajpai and Aslanian et al. teaches the elements of claim 11. However, the combined invention of Bajpai and Aslanian et al. fails to teach of an R/3 system. Cha et al. teaches of an R/3 system *(Fig. 4; page 4 lines 17-18, page 7 lines 3-10, and page 11 lines 18-24)*

It would have been obvious for a person skilled in the art at the time the invention was made to have included the R/3 system as taught by Cha et al. in the combined invention of Bajpai and Aslanian et al. This would have been obvious because the invention as taught by Cha et al. offers a time and cost efficient expert system for diagnosing problems *(page 2 lines 5-12)*. Further, it is well-known in the art to implement expert system diagnostics in an R/3 environment *(Applicant's Specification paragraph [024])*.


*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Contino whose telephone number is (571) 272-3657. The examiner can normally be reached on Monday-Friday 9:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Baderman can be reached on (571) 272-3644. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PFC  
5/17/2006

  
**SCOTT BADERMAN**  
**SUPERVISORY PATENT EXAMINER**